

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BALAKRISHNAN SRINIVASA, MAHAJAN S. SHIVRAM,
CHAPHEKAR G. MORESHWAR, GUPTA M. YESHWANT,
KULKARNI M. PARSHURAM and BANDARUPALLI R. MURTHY

Appeal No. 2003-0870
Application No. 09/046,740

ON BRIEF

Before GARRIS, PAK, and POTEATE, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 2-7 and 9-11 which are all of the claims remaining in the application.

The subject matter on appeal relates to a process for preparing thiourea from calcium cyanamide, carbon dioxide and hydrogen sulfide reagents via specifically claimed steps and parameters. This appealed subject matter is adequately illustrated by independent claim 7 and independent claim 9, a copy of which taken from the appellants' Brief is appended to this decision.

The references set forth below are relied upon by the examiner as evidence of obviousness:

Schulenburg	1,977,210	Oct. 16, 1934
Gajewski	2,337,882	Dec. 28, 1943
Cooper et al. (Cooper)	2,353,997	Jul. 18, 1944
Krulik et al. (Krulik)	3,501,524	Mar. 17, 1970

All of the appealed claims stand rejected under the first paragraph of 35 USC § 112, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the now claimed invention. It is the examiner's position that "[a]ppellants are claiming a temperature range of at least 56°C and no more than 80°C for said slurry to achieve for the process, see claims 7 and 9, step (d)" and that "there is absolutely nothing in the instant specification that would suggest a temperature of at least 56°C and no more than 80°C" (Answer, page 3).

The appealed claims also stand rejected under 35 USC § 103(a) as being unpatentable over the combined teachings of Schulenburg, Gajewski, Krulik and optionally in view of Cooper. According to the examiner, "[i]t would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to modify Schulenburg process to include temperature range of 20-70°C as taught in the analogous process of Gajewski, or alternatively adjust the alkaline pH as taught by Krulik, or optionally add calcium cyanamide in installment as taught by Cooper et al, with the reasonable expectation of achieving a high yield of thiourea, because the

variation of various conditions are expressly taught in the references, absent evidence to the contrary” (Answer, page 5).

We refer to the Brief and to the Answer for a complete exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning the above noted rejections.

OPINION

For the reasons which follow, neither of these rejections can be sustained.

As previously indicated, the § 112, first paragraph, rejection for lack of written description support is based on the examiner’s concern that “[a]ppellants are claiming a temperature range of **at least 56°C and no more than 80°C . . .**” (Answer at page 3).

The examiner’s statement is not entirely accurate. In fact, the slurry temperature range defined by the appealed independent claims ranges from a minimum “initial temperature of at least about room temperature” to a maximum “process temperature of at least 56°C and not more than 80°C” (step (d) of claims 7 and 9). Thus, the “at least 56°C and not more 80°C” (id.) temperatures about which the examiner is concerned represent the maximum slurry temperatures of the overall range claimed by the appellants.

When the temperatures of concern are viewed in this light, they clearly do not offend the written description requirement set forth in the first paragraph of § 112. This is because, as pointed out by the appellants in their Brief, lines 8-9 on specification

page 6 disclose a maximum slurry temperature of 80°C and lines 6-8 on specification page 9 disclose a maximum slurry temperature of 56°C. Plainly, these disclosures would convey to an artisan that the inventors had possession on the application filing date of the now claimed subject matter wherein the maximum slurry temperature is defined as “at least 56°C and not more than 80°C” (step (d) of claims 7 and 9). See In re Wertheim, 541 F.2d 257,265, 191 USPQ 90, 98 (CCPA 1976) which was cited by the appellants.

For the above stated reasons, we cannot sustain the examiner’s § 112, first paragraph, rejection of claims 2-7 and 9-11.

We also cannot sustain the examiner’s § 103 rejection of all appealed claims as being unpatentable over Schulenburg, Gajewski, Krulik and optionally in view of Cooper. As properly argued by the appellants, “the Examiner has failed to show how the combined references teach features (a) through (j) of independent claims 7 and 9, and the additional features recited in dependent claims 3-6 and 10-11” (Brief, page 7). Indeed, the appellants are unquestionably correct in their criticism that “[t]he Examiner continues to address only certain limitations of the claims without even attempting to show that the prior art teaches the invention as a whole” (id). In light of these deficiencies on the examiner’s part, it is apparent that his § 103 rejection would not be sustainable even if each of the examiner’s aforequoted conclusions of obviousness were assumed to be correct.

That is, the respective processes defined by the independent claims on appeal would not be achieved even if an artisan were to “modify Schulenburg process to include temperature range of 20-70°C as taught in the analogous process of Gajewski, or alternatively adjust the alkaline pH as taught by Krulik, or optionally add calcium cyanamide in installment as taught by Cooper” (Answer at page 5). This is because the appellants’ independent claims recite a number of steps which are not addressed at all by the examiner and which are not disclosed by Schulenburg and accordingly which would not be part of the process resulting from modifying Schulenburg in the afore-quoted manner. Under these circumstances, it cannot be gainsaid that the examiner’s § 103 rejection fails to satisfy the basic requirements for a *prima facie* case of obviousness as set forth, for example, in the Manual of Patent Examining Procedure at Section 2143 et seq (8th Edition, Revision 1, February 2003).

The decision of the examiner is reversed.

REVERSED

BRADLEY R. GARRIS
Administrative Patent Judge

CHUNG K. PAK
Administrative Patent Judge

LINDA R. POTEATE
Administrative Patent Judge

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